

REMARKS

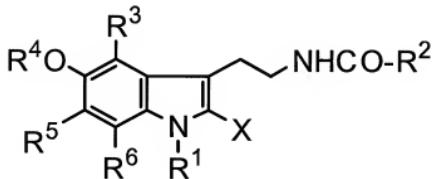
Claims 4-15 are currently pending in the present application. Claims 6-12 have been withdrawn from consideration. Claim 4 has been amended to narrow the scope of present claim. New claims 13 and 14 have been added, support for which may be found in the specification, at least, at page 3, lines 4-11; page 7, lines 9-10; and Examples 1-4, 6, 9, 14 and 15. New claim 15 has been added, support for which may be found in the specification, at least, at page 3, lines 4-8. No new matter has been added by way of the present claim amendments.

Rejection under 35 U.S.C. § 103

Claims 4 and 5 stand rejected as being rendered obvious by Tarzia et al. (Journal of Medicinal Chemistry) (hereinafter “Tarzia”).

The Examiner states that Tarzia teach 2-bromomelatonin (compound 2b).

2-Bromomelatonin (3-acetamidoethyl-2-bromo-5-methoxyindole) is a compound represented by formula (I'):



wherein X represents a bromine atom; R^1 represents a hydrogen atom; R^2 represents methyl; R^3 , R^5 and R^6 each represent a hydrogen atom; and R^4 represents methyl.

However, compound 2b of Tarzia is actually 1-(2-propanamidoethyl)-2-bromo-6-methoxyindole, not 2-bromomelatonin.

In addition, claim 4 of the present application describes “excluding the compound represented by formula (I’), wherein X represents a halogen atom; R¹ represents a hydrogen atom; R² represents methyl or cyclopropyl; R³, R⁵ and R⁶ each represent a hydrogen atom; and R⁴ represents methyl.” Therefore, the compound of claim 4 of the present application does not encompass 2-Bromomelatonin (3-acetamidoethyl-2-bromo-5-methoxyindole).

Further, the compound of claim 4 possesses the capability to activate osteoblasts and suppress osteoclasts. Such a compound is useful for pharmaceutical compositions for various bone-related diseases, such as pharmaceutical compositions for preventing or treating osteoporosis; or as an osteoblast activator and an osteoclast suppressor in various fields such as regenerative medicine, dentistry, or production of edible meats or eggs via fish cultivation or healthy development of livestock. *See* the present specification, page 9, line 24 – page 10, line 2; and Example 15.

Tarzia neither teaches nor suggests the above-noted effects of the compound of claim 4 of the present application.

With respect to claim 5 of the present application, claim 5 is directed to a compound represented by formula (I’), wherein X represents a bromine atom; R¹ represents substituted or unsubstituted C₁₋₆ alkyl, substituted or unsubstituted C₂₋₆ alkenyl, substituted or unsubstituted C₂₋₆ alkynyl, a substituted or unsubstituted aromatic group, substituted or unsubstituted aralkyl, substituted or unsubstituted acyl, substituted or unsubstituted arylsulfonyl, or substituted or unsubstituted C₁₋₆ alkylsulfonyl; R² represents methyl; R³, R⁵ and R⁶, which may be the same or different, each represent a hydrogen atom or a bromine atom; and R⁴ represents methyl.

Thus, the compound of claim 5 does not encompass 2-bromomelatonin represented by formula (I’), wherein X represents a bromine atom; R¹ represents *a hydrogen atom*; R² represents methyl; R³, R⁵, and R⁶ each represent a hydrogen atom; and R⁴ represents methyl.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection.

Rejection under 35 U.S.C. § 102

Claims 4 and 5 stand rejected as being anticipated by Naguib et al. (Anesth. Analg.) (hereinafter “Naguib”).

Naguib discloses 2-bromomelatonin.

As noted above, in the context of the discussion of 35 U.S.C. § 103, claims 4 and 5 of the present application do not encompass 2-bromomelatonin. Moreover, Naguib neither teaches nor suggests the above-noted effects associated with the compounds of the present invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection.

Rejoinder

In view of the foregoing, Applicants believe claims 4 and 5 of the pending application are in condition for allowance. Claims 6-9 and 13-15 depend from and require all of the limitations of allowable claims 4 and 5. Therefore, Applicants respectfully request that the Examiner withdraw the previous Restriction Requirement and rejoin claims 6-9 to the elected group.

A Notice of Allowance is earnestly solicited.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: FEB 28 2009

Respectfully submitted,

By 
Gerald M. Murphy, Jr.
Registration No. 28,977
MTC 
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant